

novel and nonobvious (e.g., claims 6 and 8) strongly suggests that the prior art fails to provide a suggestion or motivation to use such a composition in a process of making an antireflection film, or in an optical element comprising an antireflection film from the recited composition. *In re Bower*, 37 USPQ2d 1063 Fed. Cir. 1996). MPEP 2116.01. Accordingly, claims 9-15, at least to the extent they depend from or incorporate the limitations of claims 6 and 8, also should be considered allowable.

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Belleville et al. (U.S. Patent No. 6,387,517). Although applicants have argued that anticipation requires that a single prior art reference must specifically or inherently describe each and every limitation set forth in the claims, the Office takes the position that since Belleville et al. teaches that the layer of polymeric material based on tantalum oxide can also include "at least one other metal or metalloid oxide, chosen preferably from among" eleven (11) oxides, the prior art covers all the listed material (Belleville et al. at col. 7, lines 6-16). The examiner agrees that the specific combination of materials claimed is not explicitly or even inherently taught by Belleville, but maintains that this reference is sufficient to teach the presence of the claimed materials in a composition. This rejection is traversed.

As the Office has admitted that Belleville does not explicitly or inherently disclose the claimed combination, it cannot properly maintain a rejection based on anticipation. There are court cases that have found anticipation based on a generic disclosure where the choices were sufficiently limited or well delineated. For example, the court has found that a genus that covered only 22 compounds coupled with a description of certain preferences that were present in the claimed compounds was sufficient to

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support anticipation. See *In re Petering*, 133 USPQ 275, 279 (CCPA 1962); MPEP 2131.02. Unlike the circumstances in Petering, however, there are 2047 possible combinations of tantalum oxide and one or more of the other 11 oxides taught in Belleville, and none of the examples or any other preference described by Belleville et al. contains even one of the three oxides recited in claim 1. Belleville et al. does not contain a teaching sufficient to anticipate claims 1 and 2. Accordingly, withdrawal of this rejection is requested.

Claims 9/1 and 10-14 (presumably also to the extent they are dependent on claim 1) have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Belleville et al. in view of Rahilly (U.S. Patent No. 4,116,717). The Office recognizes that Belleville et al. lacks reference to sintering of the oxides prior to the vaporization, even though this reference acknowledges (col. 1) that such process steps are conventionally employed in preparing layers for optical elements. Belleville et al. seeks to avoid the conventional physical processes of sintering and deposition under vacuum, opting instead for the use of an inorganic polymer that is densified and cross-linked by a heat treatment at a moderate temperature or by exposure to ultra-violet rays (Belleville et al. at col. 6, lines 38-43).

In addition to the lack of anticipation, Belleville et al. neither teaches nor suggests nor otherwise motivates a person skilled in the art to select three oxides recited in claim 1 or any other claim present in this application in combination. Absent such a teaching or motivation, the mere fact that it may be possible to select oxides from among the oxides suggested by Belleville et al. is simply not sufficient to establish a *prima facie* case of obviousness. As noted in *In re Mills*, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990),

the mere fact that a prior art teaching could be modified to meet the limitations of the present claims is not sufficient to make the modification obvious unless the prior art suggests the desirability of the modification.

As pointed out by the Office, Rahilly does teach that a conventional antireflecting coating such as tantalum oxide or silicon oxide can be applied following sintering (col. 3, lines 23-28). However, Rahilly uses a process for deposition of the antireflection film that Belleville et al. seeks to avoid, and there is nothing in Rahilly that would motivate a person skilled in this art to select at least the three oxides recited in claim 1 for such a layer or to predict that such a layer containing these oxides could be successfully deposited using sintering and vacuum vaporization techniques. The only reference (Belleville et al.) that broadly suggests a combination of oxides does not use sintering and vacuum evaporation techniques to deposit such a layer, and expressly avoids using these techniques. The Office has failed to establish a *prima facie* case of obviousness since the prior art contains no motivation to combine the teachings of Belleville et al. with Rahilly, there is no predictability of success without resort to applicants specification, and even when combined, there is no teaching to combine the oxides recited in claim 1. Accordingly, this rejection should be withdrawn.

Claims 15-17 (again, presumably to the extent that they are dependent on claim 1) have been rejected as being unpatentable over Belleville et al. in view of Rahilly and further in view of Asai et al. (U.S. Patent No. 5,116,644). In addition to the deficiencies of Belleville et al. and Rahilly discussed above, Asai et al. fails to provide any teaching that would cure these deficiencies or otherwise provide a motivation to select the unique

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combination of oxides recited in claim 1 to be deposited in the manner recited in claim 9 to meet the limitations of these claims. Accordingly, this rejection should be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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